

REMARKS

The undersigned appreciates the telephonic conference with the Examiner on November 2, 2006 for clarifying a rejection basis of certain claims.

The Examiner has rejected independent claim 1 under 35 U.S.C. §112, Second Paragraph. The Examiner has also rejected independent claim 1 under 35 U.S.C. §102. Furthermore, the Examiner has rejected independent claims 3, 4 and 10 through 12 and 22 under 35 U.S.C. §103 as being unpatentable over Holleran et al. in view of Krishnaswamy et al. The Examiner has rejected independent claim 2 under 35 U.S.C. §103 as being unpatentable over Holleran et al. and Krishnaswamy et al. further in view of Taylor et al. The Examiner has rejected independent claims 5 through 9 under 35 U.S.C. §103 as being unpatentable over Holleran et al. and Krishnaswamy et al. further in view of Ouchi. The Examiner has indicated that claims 13 through 21 have been rejected “under the same rationale” as claims 1 through 12 and 22.

In view of the above claim amendment and the following remarks, the Applicant respectfully requests the Examiner to reconsider the pending rejections.

The Section 112 Rejections

The Examiner has rejected independent claim 1 under 35 U.S.C. §112, Second Paragraph for being indefinite as “the second address” lacks proper antecedent basis. Accordingly, claim 1 has been amended to now recite “the second device” to secure proper antecedent basis. Thus, the Applicant respectfully submits that the section 112, Second Paragraph should be withdrawn.

The Section 102 Rejections

The Examiner has rejected independent claim 1 under 35 U.S.C. §102(b) as allegedly being anticipated by the Holleran et al. reference. In addition, the Examiner has indicated in Paragraph 26 of the pending Office Action that claims 13 through 21 have been rejected “under the same rationale” as claims 1 through 12 and 22. Since the Examiner has rejected independent claim 1 under 35 U.S.C. §102 while he has rejected claims 2 through 12 and 22 35 U.S.C. §103, it is not clear whether the Examiner has rejected independent claim 21 under 35 U.S.C. §102 or §103. For this reason, the undersigned conferred with the Examiner on November 2, 2006 to confirm that independent claim 21 has been also rejected under 35 U.S.C. §102.

The Examiner has pointed out in Paragraph 8 of the currently pending Office Action that the Holleran et al. reference allegedly discloses every subject matter limitations of the pending independent claim.

Previously amended independent claims 1 and 21 each explicitly recite “automatically generating a new address definition based upon the corresponding predetermined rule definition at the second device....” In other words, a new address is automatically generated according to a predetermined rule. Furthermore, the predetermined rule definition is “to generate a new address” in the independent claim.

The Holleran et al. reference discloses an apparatus for depicting an electronic mail address in either a filed format or a string format. As described with respect to pairs of Figures 6B and 6C, Figures 8 and 9, Figures 11a and 11b as well as Figures 12a and 12b, the same address is shown either in the filed format or the string format. The string format shows the address information in an unformatted way. On the other hand, the field format shows the same address in a predetermined formatted way. For example, Figure 11a illustrates the format style by displaying “Pat Holleran” and “3rd Floor” in the

two predetermined units of information as name and zone. On the other hand, Figure 11b illustrates the string style by displaying “PatHolleran@3rd Floor,” which includes the same information. Regardless of the format, the Holleran et al. reference discloses an identical address or information, and no new address is generated.

In sharp contrast, the current invention as explicitly recited in independent claims 1 and 21 calls for “automatically generating a new address definition based upon the corresponding predetermined rule definition at the second device....” [emphasis added] Since the Holleran et al. reference fails to anticipate the generation of “a new address,” the alleged anticipation of independent claims 1 and 21 appears inappropriate. Thus, the Applicant respectfully submits that the rejection of independent claims 1 and 21 under section 102 should be withdrawn.

The Section 103 Rejections

The Examiner has rejected independent claims 3, 4 and 10 through 12 and 22 under 35 U.S.C. §103 as being unpatentable over Holleran et al. in view of Krishnaswamy et al. The Examiner has rejected independent claim 2 under 35 U.S.C. §103 as being unpatentable over Holleran et al. and Krishnaswamy et al. further in view of Taylor et al. The Examiner has rejected independent claims 5 through 9 under 35 U.S.C. §103 as being unpatentable over Holleran et al. and Krishnaswamy et al. further in view of Ouchi.

The Examiner has indicated in Paragraph 26 of the pending Office Action that claims 13 through 21 have been rejected “under the same rationale” as claims 1 through 12 and 22. Since the Examiner has rejected independent claim 1 under 35 U.S.C. §102 while he has rejected claims 2 through 12 and 22 35 U.S.C. §103, it is not clear whether the Examiner has rejected claims 13 through 21 under 35 U.S.C. §102 or §103. For this reason, the undersigned conferred with the Examiner on November 2, 2006 to confirm

that claims 13 through 20 have been rejected under 35 U.S.C. §103 while claim 21 has been rejected under 35 U.S.C. §102. However, a careful review reveals that the subject matter limitations of claims 13 through 20 do not necessarily correspond to claims 2 through 11. For the purpose of the current response, it is assumed that claims 13 through 20 have been rejected under 35 U.S.C. §103 as being unpatentable over Holleran et al. and Krishnaswamy et al. further in view of Taylor et al. or Ouchi.

Independent claim 12 also explicitly recites “said second device ... automatically generating a new address definition based upon the corresponding predetermined rule definition” Previously amended independent claim 22 similarly recites “automatically generating a new address definition based upon the corresponding predetermined rule definition at the second device....” In other words, a new address is automatically generated according to a predetermined rule rather than being merely formatted. Furthermore, the predetermined rule definition is “to generate a new address” in the independent claims.

As discussed above, the Holleran et al. reference discloses an apparatus for depicting an electronic mail address in either a filed format or a string format. As described with respect to pairs of Figures 6B and 6C, Figures 8 and 9, Figures 11a and 11b as well as Figures 12a and 12b, the same address is shown either in the filed format or the string format. The string format shows the address information in an unformatted way. On the other hand, the field format shows the same address in a predetermined formatted way. For example, Figure 11a illustrates the format style by displaying “Pat Holleran” and “3rd Floor” in the two predetermined units of information as name and zone. On the other hand, Figure 11b illustrates the string style by displaying “PatHolleran@3rd Floor,” which includes the same information. Regardless of the format, the Holleran et al. reference discloses an identical address or information, and no new address is generated.

The Krishnaswamy et al. reference generally discloses systems and methods of routing and managing telephone calls, data and other multimedia information including audio and video through a switched network such as a Public Switched Telephone Network (PSTN) which includes transfer of information across the Internet. In managing the above system, a user profile information is stored, and the user information includes name, address, fax number, IP address and e-mail address as disclosed in column 27.

Furthermore, the Krishnaswamy et al. reference discloses "X. INTERNET TELEPHONY AND RELATED SERVICES" in columns 74 through 113. The communication in the Internet telephony includes connections between 1) PC to PC, 2) PC to PSTN, 3) PSTN to PC and 4) PSTN to PSTN. To manage these communication transactions, the user profile method is created based upon the information that is gathered from individual users as disclosed in column 108. The information includes name, address, e-mail address and IP addresses that have been already generated before and stored elsewhere. The user must input the above information.

In relation to billing of these communication as disclosed in "XXI, BILLING" in columns 267 through 282, the Krishnaswamy et al. reference discloses "Network Call Identifiers" (NCID) for identifying each of the communication transactions. As illustrated in the flow charts in FIGURES 92, 93 and 94A, a NCID is generated. As described with respect to FIGURE 94A in column 279, the step 3114 of FIGURE 92 generates a NCID to reference a particular call. Each NCID includes a sequence number and a time value for an associated port. Thus, the NCIDs will be used to reference a particular call for the purpose of billing. Although the NCID is generated on the fly, the NCID is not associated to "the address definition" Again, no new address is generated, and no suggestion is provided for the new address definition in the Krishnaswamy et al. reference.

The Ouchi reference generally discloses a message-based workflow systems and methods for computer networks. By use of the e-mail based system, the Ouchi reference exemplifies a workflow of submitting, approving and reimbursing business expenses for predetermined projects. For each project, a predetermined set of e-mail addresses is assigned to perform the above exemplary tasks. For example, the approval task is performed by a predetermined singular manager or one of pre-assigned managers depending upon the employee who submits the request. In any case, the e-mail addresses are stored in advance for various employees, tasks and projects, and the predetermined rules or conditions simply determine to retrieve one of the previously stored e-mail addresses. In other words, the retrieved address is not “automatically” generated, but simply retrieved.

The Taylor et al. reference discloses an integrated system for electronic mail, facsimile transmission, terminal emulation and file synchronization among distributed computers. An electronic address book allows information to be efficiently sent to users of both electronic mail and facsimile transmission. To optimize the communication, five types of address cards are implemented to include a person card, a group card, a computer card, a calling card and a service card. For example, the person type address cards hold personal and destination information about a specific person or entity. Similarly, the group type address cards hold group/personal and destination information about a specific person or group. The personal/group and destination information further include a list of “electronic mail addresses” as well as phone and fax numbers. The only existing mail addresses are stored, and no new mail addresses are “automatically” generated.

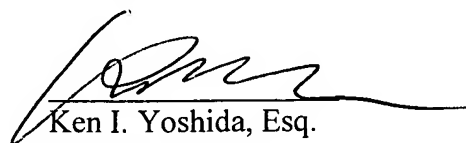
For the above reasons, even if the four cited references are combined in any manner, no teaching, disclosure or suggestion is provide based upon the combined cited references for the generation of a new address that is different from an existing one.

Dependent claims 2 through 11 ultimately depend from independent claim 1 and incorporate the patentable feature of “automatically generating a new address definition based upon the corresponding predetermined rule definition at the second device....” Similarly, independent claims 12 and 22 explicitly both recite the patentable feature of “automatically generating a new address definition based upon the corresponding predetermined rule definition at the second device....” Dependent claims 13 through 20 ultimately depend from independent claim 12 and incorporate the same patentable feature of independent claim 12. Thus, it would not have been obvious to one of ordinary skill in the art to provide the patentable feature of the independent claims based upon the four cited references alone or in combination. Therefore, the Applicant respectfully submits the Examiner to withdraw the rejections of claims 2 through 20 and 22 under section 103.

Conclusion

In view of the above remarks and attachments, the Applicants respectfully submits that all of the pending claims are in condition for allowance and respectfully request a favorable Office Action so indicating.

Respectfully submitted,



Ken I. Yoshida, Esq.
Reg. No. 37,009

Date: November 13, 2006

KNOBLE YOSHIDA & DUNLEAVY LLC
Eight Penn Center, Suite 1350
1628 John F. Kennedy Blvd.
Philadelphia, PA 19103
(215) 599-0600